

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

APPEAL UNDER SECTION 109 No 3 of 1994

with

CIVIL APPLICATION No 22 of 1994

For Approval and Signature:

Hon'ble MR.JUSTICE R.BALIA.

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1. Whether Reporters of Local Papers may be allowed  
to see the judgements? Yes
2. To be referred to the Reporter or not? No
3. Whether Their Lordships wish to see the fair copy  
of the judgement? No
4. Whether this case involves a substantial question  
of law as to the interpretation of the Constitution  
of India, 1950 of any Order made thereunder? No
5. Whether it is to be circulated to the Civil  
Judge? No

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CARMINOL LABORATORIES PVT.LTD.

Versus

S.S.M.PHARMACEUTICALS PVT.LTD

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Appearance:

1. APPEAL UNDER SECTION 109 No. 3 of 1994  
MR RR SHAH for Petitioner  
Respondent No. 1 served  
Respondent No. 2 served
2. CIVIL APPLICATION No 22 of 1994  
MR RR SHAH for Petitioner  
M/S ANAND ADVOCATES for Respondent No. 1  
Respondent No. 2 served

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CORAM : MR.JUSTICE R.BALIA.

Date of decision: 24/07/98

ORAL JUDGEMENT

1. Heard learned counsel for the appellant. None appears for the respondent.

2. This Appeal is filed to impugn order of Assistant Registrar dated 11th August, 1992 accepting Application No.451364 of the respondent No.1 in class 5 for the registration of a word mark 'CARMIZYME' in part B of the Register for the specification of goods reading as Medicinal preparations. The application was filed on 20th March, 1986. The user of the mark was claimed by the applicant - respondent since 1st October, 1982. The application was advertised under proviso to sub section (1) of Section 20 of the Trade and Merchandise Marks Act, 1958. The appellant had opposed the registration of respondents mark on the ground that opponents are using that mark 'CARMIZYME' since November 1974 and their application for registration of the said mark is pending under No. 396907. The said application was filed on 23rd October, 1982. The name of the appellant company is 'Carminol Laboratories Pvt. Ltd.' The opponents claim is that taking the word 'CARMI' from the trade name and by joining it with word 'ENZYME', they have found a new word for marketing their drugs in question. Thus, the application was opposed, inter alia, on the ground the prior user of the mark and original inventor of the word and also on the basis of their application in respect of the same mark.

3. The learned Assistant Registrar rejected the opposition by holding that the opponents have failed to prove their user since 1974 and concluded that from the evidence it appears that opponents are trying to establish their claim of the use since the year 1974 in these proceedings without any basis and substance and has raised question mark on the appellant's claim to the user of word 'CARMIZYME' to take the advantage of goodwill built around the applicants drug CARMIZYME proved to be in use since 1982. It also held that the applicants claim that the applicants are using the impugned mark since 1st October, 1982 extensively and voluminously.

4. In view of the aforesaid finding, learned Assistant Registrar disallowed the Opposition with costs and Application No. 4513648 dated 20th March, 1986 has been allowed. Aggrieved with the said decisions, opponents have filed this Appeal.

5. It has been stated by the learned counsel for the appellant that the Assistant Registrar has seriously erred in ignoring the fact that the petitioner's prior application was not being disposed of for the registration of the very same mark which was directly referable to a mark coined by the opponents in consonance with their company's name. It was also pointed out that respondent has prior to the present application has moved for registration of the very same mark, fate of which has not been disclosed. He has also referred to use of word 'CARMi' in relation to various drugs by the appellants which are manufactured and marketed by it in a large scale.

6. Having considered the contention of the learned counsel for the appellant and perused the order and record made available, I am of the opinion that the order of the Assistant Registrar suffers from apparent contradictions and deserves to be set aside. First and foremost it is to be noticed that it is not disputed that application filed by opponent for registration of mark 'CARMIZYME' is founded on its use since 16th October, 1974 and that application has not been disposed of. The application is numbered as 396907 and filed on 23rd October, 1982, that is to say, almost three and half years before the present application has been filed by the respondent. Thus, the claim to use word 'CARMIZYME' in respect of the drugs manufactured by opponent is at least from October 1982. The use of the mark in respect of drug in question is claimed by the respondent only from 1982 and if one refers to the affidavit to which learned Assistant Registrar has adverted to for the first time the respondent company has started using the word 'CARMIZYME' from 1st October, 1982. It must be held that a mark which has been alleged to be put in use only on 1st October, 1982, there cannot be a goodwill acquired by that mark by 23rd October, 1982 so as to draw a reasonable inference to impute the intention to usurp the goodwill of the mark used by respondent on the part of the opponent when he made the application in October 1982 with claim of user since 1974. In this connection, it is pertinent to notice that for very same mark the respondent has also filed an earlier application No. 3995616B on 1st January, 1983 but admittedly because of the lack of user evidence it was not pursued. It is not understood nor any material has been referred to, if respondent had no evidence of user since 1982 while

pursuing application filed in January 1983 on what basis the learned Assistant Registrar has arrived at the conclusion that the applicant has established their use of mark since 1982. If the evidence which is now referred as to use of impugned mark in 1982 by respondent was available with the respondent while they were pursuing very application dated 1st January, 1983 referred to in the order by Assistant Registrar on the basis of affidavits submitted on behalf of applicants in their counter statement the application of 1983 would not have been left unpursued. It appears that while arriving at conclusion in latter part of the order under appeal, the learned Assistant Registrar has totally ignored the above fact.

7. While referring to the evidence relating to users after 1988 and the evidence on the part of the appellant, the user of the mark, attempt on the part of the opponents to using of the mark of the respondent, he has ignored that the opponents had themselves filed an application in October, 1982. That is about the time when the respondents claim to have put their commodity in the market under the name in question for the first time. The appellant had in fact in October 1982 put its claim to user since 1974. Therefore, the claim to user since 1974 is not an invention after filing of the present application, but is from beginning with filing of the application which the Assistant Registrar has not cared to investigate until now on the ground that another prior application is pending for registration of a similar mark namely 'CARMIZYME' made by one Dr. V. Subbarao which is numbered as 357979. This fact, not only negatives the conclusion of the Assistant Registrar about lack of bona fide or about unbecoming conduct of the opponent in putting forward his claim to the use of word 'CARMIZYME' since 1974 but also discloses discriminatory treatment in the matter of considering application for registering a mark of like nature in respect of same or similar commodity, vis-a-vis two sets of applicants per se. While present appellants application of 1982 is not being considered by him on the ground of pendency of a still prior application, much latter application is being considered and adjudicated notwithstanding his attention having been drawn to this fact. As the word 'CARMIZYME' is not registered, Sec.12(2) may not be attracted in strict sense, there ought to be a strong reason for the same authority to treat differently in the matter of considering latter application. It has further been pointed out by the learned counsel that not having disclosed the exact date of user of mark in his

Application dated 1st January, 1983 the date of 1st October has been disclosed later on to predate the date of user by the respondent vis-a-vis the date of application filed by the appellant. But, in fact, the evidence in the form of bill which has been produced by the respondent is of bill dated 10th November, 1982 which is, after the making of the application by the appellant.

8. He has not all applied his mind to the facts and considered the contention of the appellant about coining the name by him in consonance with company's name and whether the joining of two words as explained by the respondeat 'CARMIZYME' does not make the word descriptive of the character of the commodity not liable to be registered unless its distinctiveness is proved.

9. The above facts clearly establish the fact that the Registrar has not acted fairly and in accordance with law in considering the application of the applicant respondent and in arriving at the conclusions on the material before it by different yardsticks to the parties, which vitiates his order.

10. In the aforesaid circumstances, the Order under appeal is set aside and Assistant Registrar is directed to decide the application afresh in accordance with law.

11. In view of the order passed in Appeal, no order on Civil Application and the same stands disposed of as infructuous.

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p.n.nair